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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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|-----------------|-------------|----------------------|---------------------|

09/611,905 07/07/00 BURKE

B EPC-80

EXAMINER

TM02/1108

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ART UNIT

PAPER NUMBER

2164

DATE MAILED:

11/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/611905

Applicant(s)

Burke

Examiner

Aker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-6 have been examined.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because the declaration is not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a). It does not include the notary's signature and it does not include the notary's seal and venue.

Drawings

3. The drawings are objected to because the margins are too wide. Correction is required.

Specification

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4 and 6 are rejected under 35 USC 103(a) as unpatentable over Lawlor(US Pat. No: 5,220,501).

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7. As per claim 1, Lawlor teaches a method of paying future bills for financial transactions(col 10 lines 35-41)(col 34 lines 5-30)(col 34 lines 41-48). Lawlor teaches billing processes within a pay bill option which permits the user to request funds to be debited from a bank account and used to pay bills to designated creditors on specified dates(col 41 line 65-col 42 line 2) including paying a bill in the future(Fig 14B/536)(col 44 lines 38-41) as well as paying a bill periodically(Fig 14C/564) and providing ahead of time the names, account numbers, etc of payees that the user desires to pay bills to electronically(col 42 line 68-col 43 line 6). Lawlor also teaches displaying a status of the available funds in the payor's account which does not include the previously scheduled payment amounts, the payee name and a payor request to enter a desired payment amount(col 48 lines 1-7)(Fig 17B/696). Lawlor teaches paying additional bills(col 49 lines 44-48) as well as transferring funds between accounts(col 49 lines 48-50). Finally, Lawlor teaches depositing funds into an account to pay bills now(Fig 20C)(col 50 lines 40-59) or in the future(col 50 line 64-col 51 line 5). Lawlor does not specifically teach the use of a "surplus" account. It would have been obvious to one skilled in the art at the time of the invention that transfer of funds between accounts, the payment of additional bills, the utilization of future payment dates and depositing of funds into an account to pay bills now or in the future as taught by Lawlor permits the creation of a surplus account for accumulating credits in such account from financial transactions between a payor and a payee.(col 51 line 67-col 52 line 15). The motivation for this is to teach a method for crediting additional payments from a payor to a payee.

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8. As per claim 2, Lawlor teaches the method as in claim 1 wherein the step of depositing the electronic payments includes the step of the payee crediting the amounts to the surplus account in the hands of a central clearing entity so that the payee remains neutral to the amounts(col 20 lines 62-66)(col 11 lines 61-65).Lawlor fails to teach that these electronic payments are specifically “additional amounts”. It would have been obvious to one skilled in the art at the time of the invention that transfer of funds between accounts, the payment of additional bills, the utilization of future payment dates and depositing of funds into an account to pay bills now or in the future as taught by Lawlor as well as the fact that electronic payments may also include any sums as well as additional amounts permits the creation of a surplus account for accumulating credits in such account from financial transactions between a payor and a payee.(col 51 line 67-col 52 line 15).The motivation for this is to teach a method for crediting additional payments from a payor to a payee.

9. As per claim 3, Lawlor teaches a method as in claim 1 wherein said step of entering an additional amount includes calculating the additional amount from predetermined data associated with the account(col 15 lines 34-47)(col 35 lines 16-36).Lawlor fails to state specifically that this is a “surplus” account.It would have been obvious to one skilled in the art at the time of the invention that transfer of funds between accounts, the payment of additional bills, the utilization of future payment dates and depositing of funds into an account to pay bills now or in the future as taught by Lawlor as well as the fact that electronic payments may also include any sums as well as additional amounts permits the creation of a surplus account for accumulating credits in such

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account from financial transactions between a payor and a payee.(col 51 line 67-col 52 line 15).The motivation for this is to teach a method for crediting additional payments from a payor to a payee.

10. As per claim 4, Lawlor teaches a method as in claim 2 further comprising the step of printing out the status of said surplus account(col 7 lines 56-63).

11. As per claim 6, Lawlor teaches a method as in claim 3 further comprising the step of printing out the status of said surplus account(col 7 lines 56-63).

12. Claim 5 is rejected under 35 USC 103(a) as unpatentable over Lawlor(US Pat. No: 5,220,501) in view of Heibling(US Pat. No: 5,546,303) and further in view of Bush(US Pat. No: 5,475,585).

13. As per claim 5, Heibling teaches a method as in Claim 2, wherein said surplus account includes sub accounts identifying a plurality of charities(col 2 lines 16-19)(col 2 lines 25-37)(col 4 lines 28-43)(col 4 lines 47-51)(Fig 1/47/48), bank(Fig 1/44) and other sub accounts and Bush teaches depositing the additional amount via a menu selection which includes assigning predetermined portions of said surplus account to said sub accounts(col 3 lines 21-49)(Fig 1-A/12/14/16/30).Bush further teaches making deposits into a number of sub accounts(Fig 8/301/302/303/304).It would have been obvious to one skilled in the art at the time of the invention to combine Lawlor in view of Heibling to teach the above. The motivation to combine is to teach an improved method for the correlation of charitable contributions in conjunction with

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businesses as enunciated by Heibling(col 2 lines 1-4). Furthermore, it would also have been obvious to one skilled in the art at the time of the invention to combine Lawlor in view of Heibling and further in view of Bush. The motivation to combine is to teach a real time transactional processing system for consumer transactions for a wide variety of services and products as enunciated by Bush(col 1 lines 14-16).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in the public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the right to exclude granted by a patent. *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re White*, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

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1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

15. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,112,191. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

16. Claim 1 of the instant application essentially repeats most of the features listed in Burke, claim 1 (col. 18, lines 15-24). There are several changes, namely: the deletion of the recitations in the claim of “into a station of a network controlled by the payee” and “into a station of a network controlled by other than the payee and within the station apportioning the data determined by the payor” in the instant application does not change the structural operation of accumulating credits in a payor surplus account from financial transactions between a payor and a payee.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Raimu*, 168 USPQ 375. Instant claim 1, the deletion of the recitation in the claim of “into a station of a network controlled by the payee” and “into a station of a network controlled by other than the payee and within the station apportioning the data determined by the payor” from the patented claim would have been an obvious expedient as above.

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17. Claim 2 of the instant application essentially repeats most of the features listed in Burke, claim 2 (col. 18, lines 25-32). There are several changes, namely: the deletion of the recitations in the claim of “ the step of transmitting the data of the additional amount” and “in the separate station of the network” in the instant application does not change the structural operation of crediting the additional amount to the surplus account in the hands of a central clearing entity so that the payee remains neutral to these additional amounts.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. In instant claim 2, the deletion of the recitation in the claim of “ the step of transmitting the data of the additional amount” and “in the separate station of the network” from the patented claim would have been an obvious expedient as above.

18. Claim 3 of the instant application essentially repeats most of the features listed in Burke, claim 5 (col. 18, lines 42-45). There are several changes, namely: the deletion of the recitations in the claim of “ one or more ” in the instant application does not change the structural operation of entering an additional amount which includes calculating the additional amount from the predetermined data associated with the surplus account.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. In instant claim 3, the deletion of the recitation in the claim of “ one or more” from the patented claim would have been an obvious expedient as above.

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19. Claim 5 of the instant application essentially repeats most of the features listed in Burke, claim 4 (col. 18, lines 35-41). There are several changes, namely: the deletion of the recitation in the claim of "one or more" in the instant application does not change the structural operation of identifying a plurality of charities, bank and other sub accounts and depositing the additional amount which includes assigning predetermined portions of the said surplus account to the sub accounts.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. In instant claim 5, the deletion of the recitation in the claim of "one or more" from the patented claim would have been an obvious expedient as above.

20. Claims 4 and 6 are identical to the patented claims 3 and 6.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Ohmae teaches a system for making payments for transactions

-Smith teaches an automated funds collection system

22. Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday

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through Friday. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703)-308-6296 or 6306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-305-3900.

GRA

November 5, 2001